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OFFICE OF PETITIONS

In re Application of :
La Mura et al. :
Application No. 09/885,720 : DECISION ON PETITION
Filed: June 19, 2001 :
Attorney Docket No. COM-003CIA :

This is in response to the communication entitled "Request for Refund of Petition Fee," filed June 2, 2003, which is being treated as (1) a petition under 37 CFR 1.181 for refund, and (2) a petition under 37 CFR 1.183 seeking waiver of 37 CFR 1.4(b).

The petition considered under 37 CFR 1.181 for a refund is dismissed.

The petition considered under 37 CFR 1.183 as a request for waiver of the rules is dismissed.

BACKGROUND

The above-identified application papers were deposited on June 19, 2001. With the filing, applicant included a "Request for Nonpublication Pursuant to 37 C.F.R. § 1.213," which reads:

Applicant hereby requests that this application not be published under 35 U.S.C. § 122(b). Applicant certifies that the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multi-lateral agreement, that requires publication at eighteen months after filing.

However, on August 20, 2001, the office of Initial Patent Examination mailed a Notice indicating that while the instant application papers were entitled to a filing date, the application remained incomplete and the deficiencies noted therein had to be supplied within an extendable two month period or the application would become abandoned.

On September 28, 2001, applicant filed the missing items required by the Notice of August 20, 2001.

On June 12, 2002, applicant filed an international treaty (PCT) application that apparently claimed priority benefit of the instant application.

On June 19, 2002, applicant filed a "Transmittal Letter for Request to Rescind Nonpublication," along with Form PTO/SB/36 (11-00). This request stated that "I hereby rescind the previous request that the above-identified Application not be published under 35 U.S.C. 122(b)." The rescission does not make any mention of the filing of a PCT application on June 12, 2002.

On May 13, 2003, applicant filed a petition to revive under 37 CFR 1.137(f) and stated that the invention disclosed in the above-identified application was filed in a foreign country or under international treaty entailing 18 month publication on October 5, 2001. Since applicants first provided the notice of foreign filing as required by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicant filed the petition to revive on May 12, 2003, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B)(iii) was not filed within 45 days of the date of filing of the international application. As such, the above-identified application became abandoned midnight Sunday November 27, 2003.

On June 2, 2003, the instant petition was filed.

The petition under 37 CFR 1.137(f) filed May 13, 2003, is being granted in a decision mailed the same date as the instant petition, which will excuse applicant's unintentional delay in filing the necessary timely notification.

STATUTE AND REGULATION

35 U.S.C. § 122b(2)(B) states, in pertinent part:

(i) If an applicant makes a request upon filing, certifying that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing, the application shall not be published as provided in paragraph (1).

(ii) **An applicant may rescind a request made under clause (i) at any time.**

(iii) An applicant who has made a request under clause (i) but who subsequently files, in a foreign country or under a multilateral international agreement specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days after the date of the filing of such foreign or international application. **A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned,** unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

(iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).¹

37 CFR 1.213 states:

(a) If the invention disclosed in an application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the application will not be published under 35 U.S.C. 122(b) and § 1.211 provided:

(1) A request (nonpublication request) is submitted with the application upon filing;

(2) The request states in a conspicuous manner

that the application is not to be published under 35 U.S.C. 122(b);

(3) The request contains a certification that the

¹ Emphasis added.

invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing; and

(4) The request is signed in compliance with § 1.33(b).

(b) The applicant may rescind a nonpublication request at any time. A request to rescind a nonpublication request under paragraph (a) of this section must:

(1) Identify the application to which it is directed;

(2) State in a conspicuous manner that the request that the application is not to be published under 35 U.S.C. 122(b) is rescinded; and

(3) Be signed in compliance with § 1.33(b).

(c) If an applicant who has submitted a nonpublication request under paragraph (a) of this section subsequently files an application directed to the invention disclosed in the application in which the nonpublication request was submitted in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, the applicant must notify the Office of such filing within forty-five days after the date of the filing of such foreign or international application. The failure to timely notify the Office of the filing of such foreign or international application shall result in abandonment of the application in which the nonpublication request was submitted (35 U.S.C. 122(b)(2)(B)(iii)).

OPINION

Applicant requests a refund for the following reasons:

1. The position taken by the USPTO that a transmittal letter to the Receiving Office (USPTO) does not constitute notice of such filing because of the provisions of 37 CFR 1.4(b) is legally incorrect.

2. The statute, as well as the rule, does not specify the manner in which such notice of foreign filing be given to the Director, but merely provides that notice of a foreign filing be given.

3. Neither the Notice of Proposed Rulemaking, 65 FR 17946, 17957 (2000), nor the final rulemaking notice in the Official Gazette of October 10, 2000, specify or imply any requirement that the statutory notice to the Director be captioned as or even placed in the file of the United States patent application.

4. Lastly, applicant submits that the filing of the PCT request in the PCT Receiving Office of the United States serves as the notice to the Director of the filing of the PCT application as required by both 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c); that the filing of any paper in the USPTO constitutes actual notice to the Director of the filing of that paper.

Applicant additionally requests suspension of the provisions of 37 CFR 1.4(b) under 37 CFR 1.183, which latter issue will be treated first.

With respect to the petition for waiver under 37 CFR 1.183:

Since this petition is not accompanied by the \$130 fee required by 37 CFR 1.17(h) for filing a petition under 37 CFR 1.183, no consideration on the merits of the petition will be given.

With respect to the request for refund:

The legislative history relevant to the instant issues, as reported in the Congressional Record indicates that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

35 U.S.C. 122(b)(2)(B)(iii) provides that if an applicant informs the Office that the application has not been and will not be "foreign filed," such an applicant must inform the Office of the subsequent foreign filing no later than 45 days after foreign filing or the application will be treated as abandoned. Since applicant did not provide the required notice, the above-identified application is properly treated as abandoned, and the

fees for the necessary remedy fell due. 35 U.S.C. § 42(d) permits a refund of "any fee paid by mistake or any amount paid in excess of that required." Thus, the United States Patent and Trademark Office (USPTO) may refund: (1) a fee paid when no fee is required (a fee paid by mistake); or (2) any fee paid in excess of the amount of fee that is required. See Ex Parte Grady, 59 USPQ 276, 277 (Comm'r Pats. 1943) (the statutory authorization for the refund of fees is applicable only to a mistake relating to fee payment). However, petitioner has not shown, nor does inspection of the record reveal, that the fees in question were paid either in excess or by mistake. Since the fees were paid in the proper amounts, there is no question as to whether the fees were laid in excess. Further, since this application became abandoned by operation of 35 U.S.C. 122(b), the petition fee for revival of this application was not a fee paid by mistake. As such, no refund is due applicant.

Contrary to petitioner's contentions, a review of the file record fails to disclose that applicant's rescission notice filed June 19, 2002, made any mention of a foreign or international treaty filing that had or would occur. Applicant's rescission notice simply does not state that the form should be treated as notice of foreign filing pursuant to 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Nothing in a rescission of a nonpublication request implies that the U.S. application has been or will be foreign filed. Most patent applications filed on or after November 29, 2000, will be published, unless applicant files a request for nonpublication in compliance with 37 CFR 1.213(a). A nonpublication request is required to contain a certification that "the invention disclosed in the application has not been and will not be the subject of an application filed in another country, or under a multilateral international agreement that requires publication at eighteen months after filing." Applicants who do not plan to file in another country are not required to file such a certification, and given that provisional rights (see 35 U.S.C. § 154(d)) may become available to those who have their patent applications published, some applicants who do not plan to file in another country may elect to have their application published to be eligible for provisional rights. As a result, the filing of a rescission of a nonpublication request does not imply that the invention has been or will be foreign filed, and instead simply denotes that applicant now desires to have the application published in the United States, which of course may confer provisional rights.

Furthermore, if a mere notice of rescission could properly be construed as a concomitant notice of foreign filing, without any

reference to a foreign filing, then 35 U.S.C. § 122(b)(2)(B)(iii) would have included some reference to a rescission. For example, the statute could have provided that the "rescission specified in clause (ii) must be filed no later than 45 days after the date of foreign filing." Instead, clause (iii) specified that an "applicant who has made a request under clause (i)...shall notify the Director of such filing no later than 45 days after the date of such filing."

Implicit in providing notice of foreign filing is a rescission of the nonpublication request for both actions will result in publication of the application (see 35 U.S.C. 122(b)(2)(B)(iv)), but a request to publish a patent application (to rescind a nonpublication request) does not communicate any information about, or is otherwise necessarily linked to, a foreign or international treaty filing. Thus, the statute clearly identifies rescission of a nonpublication request and notification of a foreign filing as two separate acts, and a rescission in and of itself cannot be construed as notice of foreign filing.

Here, applicant's request to rescind the previously filed nonpublication request did not provide any notice of the foreign filing. Accordingly, it did not comply with 35 U.S.C. 122(b)(2)(B)(iii). The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. 122(b)(2)(B)(ii) as the notice of foreign filing required by 35 U.S.C. 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. 122(b)(2)(B)(iii), as a result, the application must be regarded as abandoned. **These are statutory requirements and a statutory requirement can not be waived under the provisions of 37 CFR 1.183.**

As to the arguments that no specific notice is required and that filing an international [PCT] application in the United States Receiving Office was the required notification of foreign filing to the Director, these arguments are also not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b) provides that each application must be complete in itself. While petitioner contends that 37 CFR 1.213 does not specify that the notification have been filed in this application, 37 CFR 1.4(b) does require that this file be complete in of itself. The PCT filing transmittal was not a paper captioned for this application within the meaning of 37 CFR 1.5.

An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application for the required notice to be properly given, at a bare minimum. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject, so a notification of foreign filing was required to be on a separate paper from another matter (such as a transmittal of a new application). 37 CFR 1.4(b) and 1.4(c) refute petitioner's contention that notice to the PCT Receiving Office operation within the USPTO is the required notice the national stage processing area(s) of a foreign or treaty filing, and likewise answer petitioner's assertion that 35 U.S.C. 122 (b) and 37 CFR 1.213 do not require that the applicant inform the USPTO of the later treaty or foreign filing by filing a notice in the prior U.S. national application.

Indeed, inspection of 35 U.S.C. 122(b) itself refutes applicant's contentions that the mere fact of filing of the PCT application operated as the required statutory notice to the USPTO. The relevant clause of 35 U.S.C. 122(b)(2)(B)(iii) sets forth that the applicant who, as here, has filed an application under a multilateral international agreement **directed to the invention disclosed in the application filed in the Patent and Trademark office, shall notify the Director... of such filing.** Thus, the obligation to make a comparison of the invention disclosed in the application filed in the United States, with the invention disclosed in the application filed in the foreign country or under the multilateral international agreement rests with the applicant who has made the filings.

Petitioner would have the USPTO believe the statute obligates the Director to make a comparison of the invention disclosed in each

applicant's U.S. application with the invention disclosed in each and every of that same applicant's foreign applications or applications filed under a multilateral international agreement to ferret out possible instances of the requisite notification. Indeed, it would be impossible for the USPTO to try to detect any--much less all--foreign or treaty filings of all those applicants who likewise have filed an application in the U.S., and then compare disclosure of the U.S. filing with that of the foreign or multilateral international agreement. Such would necessarily have to fly in the face of the applicant's certification present on filing that no such foreign or treaty filing had been or would be undertaken, on the mere chance that a possible abandonment under § 122(b) had occurred, and such unwonted effort would prevent the USPTO from performing its more substantive duty of examining the applications it has on file for patentability under §§ 102, 102, 103.

Such an interpretation of the statute is untenable and the burden such an interpretation it would place on the USPTO unbearable. But see Griffin v. Oceanic Contractors, Inc., 458 U.S. 564, 575 (1982) ("[I]nterpretations of a statute which would produce absurd results are to be avoided if alternative interpretations consistent with the legislative purpose are available.") Rather, such a burden is properly borne by those who do the diverse filings and as such are in the best position to make the relationship determination required by 35 U.S.C. 122(b)(2)(B)(i).

Indeed it would be improper for the Director to assume, contrary to what petitioner appears to contend, that each and every notification of the fact that benefit of a prior U.S. national application was being claimed upon USPTO receipt of a filing under the PCT filing was itself the notification required by 35 U.S.C. 122(b)(2)(B)(iii). If such were to be construed as a proper notification then the referenced U.S. national application would automatically be cleared for pre grant publication. However, that would tend to compromise the confidentiality requirements of 35 U.S.C. 122(a) for those referenced applications, based upon an unwarranted assumption, by the USPTO, that the PCT application was directed to the invention disclosed in the prior U.S. national application.

Moreover, the mere fact that benefit of a given prior U.S. national application may have been claimed when a PCT application was deposited with the USPTO does not mean *ipso facto* that the PCT application is directed to the invention disclosed in the given prior U.S. national application filed in the United States

within the meaning of 35 U.S.C. 122(b)(2)((B)(i)). Cf. In re Gosteli, 872 F.2d. 1008, 10 USPQ2d 1614 (Fed. Cir. 1989) (patentee's § 120 claim for benefit of filing date of an earlier filed U.S. application refused, notwithstanding satisfaction of the formal requirements to claiming benefit of the aforementioned application, since judicial determination holds later claimed invention not found in prior application); New Railhead Manufacturing LLC v. Vermeer Manufacturing Co., 63 USPQ2d 1843 (Fed Cir. 2002) (patentee's § 119(e) claim for benefit of filing date of earlier filed U.S. provisional application refused notwithstanding satisfaction of the formal requirements for claiming benefit, since judicial determination holds later claimed invention not found in prior provisional application).

Rather, a fair reading of 35 U.S.C. 122(b) reveals that it is the applicant who has filed the prior application in the U.S. and the later application under a multilateral international treaty (e.g., the PCT) or in a foreign country, who must notify the USPTO within 45 days when that treaty or foreign application is directed to the invention already on file at the USPTO. The statute does not make distinctions between whether the applicant has deposited the subsequently filed application in the USPTO as the receiving office, or with a foreign receiving office, or even with a foreign patent office; the statute requires the applicant to notify the USPTO within 45 days of that deposit if the latter filed application is for the invention disclosed in the prior U.S. application. Only the applicant, not the USPTO, is able at that time to make the determination required by statute that the latter filed application is for the invention disclosed in the prior U.S. application. Contrary to petitioner's position, the statute does not authorize, much less compel, the USPTO to determine if the later filed treaty or foreign application is for the invention disclosed in the application on file in the USPTO. If such were the case then the USPTO would have to continuously monitor all foreign patent offices and treaty application receiving offices for all priority claims involving prior U.S. filed applications, and if no notification was received within 45 days of the later filing or deposit or no withdrawal had been received in the USPTO, hold the application abandoned. Such an absurd result is avoided merely by interpreting the statute as requiring the applicant to make the comparison as well as the notification. See Griffin, supra.

This application is being returned to Technology Center AU 2164.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

A handwritten signature in cursive script, appearing to read "Brian Hearn".

Brian Hearn
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Office of the Deputy Commissioner
for Patent Examination Policy